

REMARKS**Summary of the Office Action**

Claims 1-6 and 31-32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 and 31-32 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by IBM Research Bulletin No. 32227 (February 1991) (hereinafter "*IBM'227*").

Claims 1-3 and 31-32 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by U.S. Patent No. 6,547,651 to *Boyd et al.* ("*Boyd*").

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *IBM'227* or *Boyd* in view of U.S. Patent No. 6,116,997 to *Hakomori et al.* ("*Hakomori*").

Summary of the Response to the Office Action

Applicants propose canceling claims 2, without prejudice or disclaimer, and amending claims 1 and 3-6. Accordingly, claims 1, 3-6, and 31-32 are pending for further consideration.

Receipt of Previously Submitted Materials

Applicants respectfully request acknowledgment of receipt of the Information Disclosure Statement filed October 20, 2004, and the return of initialed PTO-1449 form. Further, Applicants respectfully request acknowledgment of receipt of certified copies of Japanese Applications filed on March 3, 2004.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 1-6 and 31-32 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 1 and 3-6 have been amended to correct the ambiguities pointed out by the Examiner in the July 13, 2005 Office Action. Applicants respectfully submit that this rejection is respectfully traversed in light of the current amendments to claims 1 and 3-6. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1-3 and 31-32 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by *IBM'227*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *IBM'227* anticipates each and every feature of Applicants' invention, as currently amended, and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claims 1, 5, and 6, as amended, recite the feature of "wherein both long sides of said substantially rectangular dressing surface extend in a cone shape diverging away from said centerline in the direction of the long side of said dressing surface such that when said dressing surface is caused to contact said working surface, a contact length between said working surface and said dressing surface is equal at all positions in the radial direction of said working surface." At least these features are not disclosed or taught by *IBM'227*.

IBM'227 discloses a dressing bar 8. See *IBM'227*. However, the dressing bar 8 of *IBM'227* fails to teach or suggest at least the above-mentioned features of newly amended claim 1 which include the amended features of dependent claim 2. With respect to dependent claim 2,

the Office Action states that *IBM*'227 discloses the present invention, but does not identify any citation in *IBM*'227 that discusses "a contact length between said working surface and said dressing surface is equal at all positions in the radial direction of said working surface," features are present. Because *IBM*'227 does not disclose these features, it cannot anticipate the invention recited in amended claims 1, 5, and 6.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *IBM*'227 does not teach or suggest each feature of independent claims 1, 5, and 6.

Additionally, Applicants respectfully submit that dependent claims 31 and 32 are also allowable insofar as they recite the patentable combinations of features recited in claims 5 and 6, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 102(a)

Claims 1-3 and 31-32 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by *Boyd*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Boyd* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claims 1, 5, and 6, as amended, recite the features of "wherein both long sides of said substantially rectangular dressing surface extend in a cone shape diverging away from said centerline in the direction of the long side of said dressing surface such that when said dressing surface is caused

to contact said working surface, a contact length between said working surface and said dressing surface is equal at all positions in the radial direction of said working surface.” At least these features are not disclosed or taught by *Boyd*.

Boyd discloses a CMP apparatus for planarizing a substrate. See Abstract of *Boyd*. However, *Boyd* fails to teach or suggest at least the above-mentioned features of newly amended claims 1, 5, and 6 which include the amended features of dependent claim 2. With respect to dependent claim 2, the Office Action states that *Boyd* discloses the present invention, but does not identify any citation in *Boyd* that discusses at least “a contact length between said working surface and said dressing surface is equal at all positions in the radial direction of said working surface.” Because *Boyd* does not disclose these features, it cannot anticipate the invention recited in amended claims 1, 5, and 6.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(a) should be withdrawn because *Boyd* does not teach or suggest each feature of independent claims 1, 5, and 6.

Additionally, Applicants respectfully submit that dependent claims 31 and 32 are also allowable insofar as they recite the patentable combinations of features recited in claims 5 and 6, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *IBM'227* or *Boyd* in view of *Hakomori*. Applicants respectfully assert that dependent claim 4 is allowable at

least because of its dependence from dependent claim 3 via independent claim 1, as amended, and the reason set forth above.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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